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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/578,631

05/25/2000

William H. Barber

387953

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07/22/2004

LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301

EXAMINER

CHILCOT, RICHARD E

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,631

Applicant(s)

BARBER ET AL.

Examiner

Richard E. Chilcot, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-56 and 59-83 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 57 and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Declaration filed on 16 April 2004, under 37 C.F.R. § 1.131, has been considered but is ineffective to overcome the Kanoh et al. and Kitchen et al. references.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Kanoh et al. and Kitchen et al. references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The Exhibits submitted do not provide sufficient evidence beyond a vague concept on the solution to a problem. Specifically, there is no evidence on how billing is to be performed, credit verification, transmission of confirmation and transmission of an electronic receipt to the user. Moreover, the Declaration of Scott does not supply any evidence of a complete disclosure. Business plans and spreadsheets supplied relied upon in the declaration do not describe in sufficient detail conception of the claimed invention.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 18, 20-24, 26-29, 36-38, 42-53, 67-70, 70-79 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al. in view of Kitchen et al. Kanoh et al. show kiosks (3), which dispense CDs, see col. 1, lines 7-12, and receives the CDs back. The kiosks of Kanoh et al. are connected to a remote host computer 50, see col. 5, lines 33-40. Kanoh et al. include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned, see col. 6, lines 13-16. Kanoh et al. maintain an inventory of the rented CDs and the location of the CDs in the kiosk, see col. 7, lines 35-64. Kanoh et al. disclose electronic transmission of charges to a credit card company, see col. 4, lines 28-31, 47-49, col. 9, lines 43-50 and col. 10, lines 5-12. However, Kanoh et al. do not disclose electronically transmitting a receipt to the user. On the other hand, Kitchen et al. disclose electronically presenting bills including credit card bills to the payor, see col. 6, line 6. Since credit card bills shows charges for purchases and services and payments received, the bill comprises a receipt. Accordingly, it would have been obvious for one having ordinary skill in the art at the time of the invention to provide the device of Kanoh et al. with means to electronically transmit the credit card bill to the customer, as suggested by Kitchen et al. The motivation of such a change would have allowed the customer a complete record of the transaction.

Claims 30-32, 71 and 72 rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al. in view of Kitchen et al. as applied to claim 2 above, and further in view of Brindze et al. Kanoh et al. as modified by Kitchen et al. disclose all the features of the claimed invention with the exception of concentric markings on the CDs. Brindze et al. show CDs with unique concentric markings to keep track of each CD. It would have been obvious for the skilled artisan in view of the showing and teaching of Brindze et al. to provide the CDs of Kanoh et al. with unique concentric markings to keep track of each CD in the kiosk.

Claims 9-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al. in view of Kitchen et al. as applied to claim 1 above, and further in view of Reid et al. Kanoh et al., as modified by Kitchen et al. teach all the features of the claimed invention with the exception of a storage carousel for the CDs. Reid et al. is submitted to show a storage carousel 32 for holding the articles. Accordingly, it would have been obvious for one of ordinary skill to substitute the carousel of Reid et al. for the storage means of Kanoh et al. since the storage means are equivalent and either means would have worked equally well in the dispenser of Kanoh et al.

Claims 13, 54, 55, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al. in view of Kitchen et al. as applied to claim 1 above, and further in view of Takahashi et al. Kanoh et al., as modified by Kitchen et al. teach all the features of the claimed invention with the exception of a device to polish the CDs. It would have been obvious for one having ordinary skill in the art at the time of the invention to provide a device for polishing the CDs in Kanoh et al., as suggested by

Takahashi et al., since such a change would have removed scratches or stains from the CDs and provided a longer life to the CDs.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al., in view of Kitchen et al. as applied to claim 2 above, and further in view of Takahashi et al. Kanoh et al., as modified by Kitchen et al. teach all the features of the claimed invention with the exception of a device to polish the CDs. It would have been obvious for one having ordinary skill in the art at the time of the invention to provide a device for polishing the CDs in Kanoh et al., as suggested by Takahashi et al., since such a change would have removed scratches or stains from the CDs and provided a longer life to the CDs.

Claims 25, 34, 35, 66, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al., in view of Kitchen et al. as applied to claim 1 above, and further in view of Dedrick. Kanoh et al., as modified by Kitchen et al. teach all the features of the claimed invention with the exception of sending advertisements according to a user profile. Dedrick discloses sending advertisements according to a user profile. It would have been obvious for the skilled artisan in view of the teachings of Dedrick to tailor the advertisement in Kanoh et al. according to user profiles in order to provide a better targeted advertisement.

Claims 33, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al., in view of Kitchen et al. as applied to claim 1 above, and further in view of Iida. Kanoh et al., as modified by Kitchen et al. teach all the features of the claimed invention with the exception of an optical writing system. Iida discloses an

optical writer 28 that writes data to the CDs. It would have been obvious for of ordinary skill in the art to provide the device of Kanoh et al. with an optical writer, as suggested by lida, in order to provide customized CDs to the customer.

Claims 39-41 and 80-82 rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al., in view of Kitchen et al. as applied to claim 1 above, and further in view of lida. Kanoh et al., as modified by Kitchen et al. teach all the features of the claimed invention with the exception of a casing with an address and packaging for mailing. lida discloses a casing with an address and packaging for mailing the CDs in col. 15, lines 16-22. Accordingly, it would have been obvious for of ordinary skill in the art to provide the device of Kanoh et al. with a casing and means to address and mail the CDs, as suggested by lida, in order to provide a complete customer service to remote customers.

Allowable Subject Matter

Claims 16, 17, 57 and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

This is a RCE of applicant's earlier Application No. 09/578,631. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**

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even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard E. Chilcot, Jr. whose telephone number is 703-305-4716. The examiner can normally be reached on 5/4/9 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard E. Chilcot, Jr.
Primary Examiner
Art Unit 3627